



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,347	01/22/2001	Daryl E. Eicher JR.	58462.000004	9043

29315 7590 04/01/2004

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC  
12010 SUNSET HILLS ROAD  
SUITE 900  
RESTON, VA 20190

EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/765,347

Applicant(s)

EICHER ET AL.

Examiner

Jan Mooneyham

Art Unit

3629

My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is response to the communication filed on January 22, 2001. Claims 1-47 are currently pending in this application.

#### ***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on May 9, 2001, September 24, 2001, January 21, 2003 and October 16, 2003 are being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Art Unit: 3629

In the present case, claims 1-47 only recite an abstract idea. The recited step enabling a buyer and supplier to initiate a buyer-supplier engagement, monitoring performance and enabling the buyer and seller to participate in buyer-supplier engagement to collaborate regarding issues does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The invention does not recite technology in the body of the claims.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

#### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

4. The applicant has skipped Claim 8.

#### ***Claim Rejections - 35 USC § 112***

5. Claims 2-7, 19-24, and 35-39 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3629

How is a violation indicated?

It is not clear how or when the collaboration module is automatically initiated?

It is not clear what the applicant identifies as an alert or an alert module?

In Claims 12, 28, and 43, what does the applicant mean by “an alert module escalates the issue”?

6. Referring to Claims 1, 18, and 34:

What does the applicant mean by the term “module”?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 9-14, 18, 25-30, 34, and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al. (US Patent 6,338,050) (hereinafter referred to as Conklin).

Referring to Claims 1, 18, and 34:

Conklin discloses method and system for performance-based supply chain management comprising the steps of:

Enabling a buyer and supplier to initiate a buyer-supplier engagement, the buyer-supplier engagement providing an identification of a product to be supplied and at least one key performance indicator (KPI) (contract terms) by which performance of that buyer-supplier engagement is to be monitored (col. 14, lines 1-14);

Art Unit: 3629

Monitoring performance of the buyer-supplier engagement through communications exchanged between the buyer and supplier through a server module associated with the monitoring module, the monitoring being based on the at least one identified key performance indicator (contract terms) (col. 14, lines 1-14); and

Enabling the buyer and seller participating in a buyer-supplier engagement to collaborate regarding issues related to one or more key performance indicators identified for the buyer-supplier engagement (col. 14, lines 1-14).

It is noted that even though Conklin does not explicitly disclose specific operating systems such as an engagement. Monitoring, enabling or server module. However, it would have been obvious to one of ordinary skill in the art that these operating system are desirable and required to produce an operational system incorporating the present invention.

Referring to Claims 9, 25, and 40:

Conklin discloses a method and system wherein the collaboration session provided is provided an open, secure collaboration environment (col. 14, lines 49-56, col. 15, lines 19-27, col. 20, lines 47-61).

Referring to Claims 10, 26, and 41:

Conklin discloses a method and system further comprising the step of enabling the exchange of documents during the collaboration (col. 18, lines 47-65, col. 20, lines 49-53).

Referring to Claims 11, 27, and 42:

Conklin discloses a method and system further comprising enabling participants to close out an issue related to the key performance indicator (Fig. 1e).

Art Unit: 3629

Referring to Claims 12, 28, and 43:

Conklin discloses a method and system further comprising alerting another participant if the collaboration participants are unable to close out an issue (col. 19, lines 28-37)

Referring to Claims 13, 28 and 44:

Conklin discloses a method and system wherein the server system through which collaboration is provided extracts data and dialog exchanged into an archive (Fig. 1g, Online Order History, Fig. 1i, 212-10 (Store this round), col. 14, lines 61-64)

Referring to Claims 14, 30 and 45:

Conklin discloses a method and system comprising the step of storing collaborations between participants into a collaboration archive (Fig. 1g On Line Order History, 1i 212-10, col. 14, lines 61-64).

8. Claims 2-7, 15-17, 19-24, 31-33, 35-39, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al. in view of Young (US 2002/0038217) (hereinafter referred to as Young) and further in view of Solomon (SU 2003/0233305) (hereinafter referred to as Solomon).

Referring to Claims 2, 19, and 35:

Conklin discloses a method and system as to Claims 1, 18 and 34. Conklin does not disclose a method and system further comprising automatically initiating a collaboration session between a buyer and supplier upon determination of a violation with respect to a key performance indicator for the buyer-supplier engagement. However, Young discloses method and system further comprising determining a violation with respect to a key performance

Art Unit: 3629

indicator for the buyer-supplier engagement (page 1 [0005], page 2 [0017]. Solomon discloses automatically initiating a collaboration session between a buyer and supplier upon the determination of a violation (Fig. 68).

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Conklin the teachings of Young and Solomon since this would allow for the system to analyze, search, negotiate for and complete a commercial transaction

Referring to Claims 3, 4, 20, 21, and 36:

Young discloses a method and system further comprising alerting buyer or supplier of a value of a key performance indicator to enable the buyer or supplier to initiate a collaboration session on a resolution with respect to the key performance indication (Fig. 3, page 1 [0005] and page 2 [0017]).

Referring to Claims 5, 22 and 37

Conklin further discloses a method and system wherein the alerted participant invites other participants to collaborate (Fig. 1f, col. 19, lines 27-37).

Referring to Claims 6, 23, and 38:

Conklin discloses a method and system wherein the alerted participant invites other participants by providing an electronic address (col. 19, lines 27-37, col. 26, lines 3-10).

Referring to Claims 7, and 24 and 39:

Conklin discloses a method and system wherein the invited participant is sent an electronic message to the electronic address to notify that participant regarding the collaboration (col. 25, line 52 thru col. 26, line 10, Fig. 7 (535)).



Art Unit: 3629

Referring to Claims 15, 31, and 46:

Conklin discloses a method and system wherein the collaboration archive stores tradeoff analysis and violation details (Conklin stores the history – Fig. 1g, Fig. 1i).

Referring to Claims 16, 32 and 47:

A method and system further comprising the step of utilizing stored collaboration information as prior performance data for use in enabling buyers and suppliers to enter a buyer-supplier engagement (evaluating proposed terms between buyers and sellers (col. 23, line 64 thru col. 24, line 12)).

Referring to Claims 17 and 33:

Solomon discloses a method and system where a buyer-supplier matching function is provided by the engagement module and wherein the collaboration information is at least one factor used by the function in selecting potential buyer-supplier matches (Fig. PA3).

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

[www.seecommerce.com](http://www.seecommerce.com) discloses a system that measures performance and diagnoses problems and automatically alerts the business managers.

E Manufacturing solutions discloses new technology which automates not only production monitoring but also the resolution to problems that arise.

Shahong Zheng discloses a supply chain management system.

Bhaskaran discloses an active coloration technology in an open architectural framework.

Work discloses a method and apparatus for monitoring transactional events in a supply chain.

Zarefoss discloses a system and method for supply chain management which monitors specific performance indicators.

Hewlett Packard Patent discloses a method for carrying out electronic commerce over the Internet.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**

JM